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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,803	09/28/1999	TSUGIO OKAMOTO	Q056006	1953

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EXAMINER

MEHRA, INDER P

ART UNIT	PAPER NUMBER
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2666

DATE MAILED: 09/11/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/406,803

Applicant(s)

OKAMOTO, TSUGIO

Examiner

Inder P Mehra

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Response to Amendment

1. This is in response to an amendment (Response) dated 6/24/03, which has been fully considered and made of record. Based on this amendment, claims 1-10 are now pending. In view of the following new ground of rejection, this office action is Non-Final.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-2, 4, 6-7 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Backes et al (US Patent No. 5,956,335), hereinafter, Backes.

For claims 1-2, 4, 6-7 and 9, Backes discloses, in reference to figs. 1-6B, a method of transmitting packets between first and second networks of different address formats, figs. 2 and 3, refer to col. 3 lines 14-19 and col. 8 lines 23-42; comprising the steps of:

- receiving from a first network, a packet containing first address data conforming to the first network and second address data conforming to a second network, the first address data being contained in a packet header of the packet and the second address data contained in auxiliary (encapsulated) header of the packet, figs. 1, 4-6B, refer to col. 3 lines 20 through col. 5 line 27 and col. 8 lines 23-42;

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- rewriting the first address data with the second address data (translated into functional address which is written into a second frame which, further translate the functional address into a multicast address and writes the multicast address into the destination address), abstract, figs. 1-6B, refer to col. 4 lines 23 through col. 5 line 27;
- transmitting the packet to the second network, refer to abstract and col. 2 lines 24-32.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 5, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Backes et al** as applied to claims 1 and 6 above, and further in view of **Gang Jr.**(US Patent No. 4,897,841).

For claims 3 and 8, Backes discloses all the subject matter of the claimed invention, refer to paragraph 4 above, with the exception of the limitation: "eliminating from the packet a field in which the second address data is contained";

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Gang Jr. discloses eliminating from the packet a field in which the second address data is contained (some fields eliminated, refer to col. 3 lines 14-16 and removing the field 160, refer to col. 4 lines 8-10”;

A person of ordinary skill in the art would have been motivated to employ Gang Jr.’s system for bridging LANs into Backes’s system in order to add the capability of eliminating second address field. The suggestion/motivation to do so would have been to remove some fields and add others. It would have been obvious to a person of ordinary skill in the art to remove the second address field and substitute with others to place the message on the network.

For claims 3 and 8, Backes discloses all the subject matter of the claimed invention, refer to paragraph 4 above, with the exception of the following limitations:

- making a search through a received packet;
- examining a database if the auxiliary header is not contained in the received packet and detecting address data mapped to the first address data; and
- converting the first address data with the detected address data.

Gang Jr. discloses the following limitations, refer to col. 6 line55 through col. 7 line 3 :

- making a search through a received packet;
- examining a database if the auxiliary header is not contained in the received packet and detecting address data mapped to the first address data; and
- converting the first address data with the detected address data.

A person of ordinary skill in the art would have been motivated to employ Gang Jr.’s

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system for bridging LANs into Backes's system in order to add the capability of examining a database and detecting address data mapped to the first address data; and converting the first address data with the detected address data. The suggestion/motivation to do so would have been to convert the first address data with the detected address data. It would have been obvious to a person of ordinary skill in the art to examining a database if the auxiliary header is not contained in the received packet and detecting address data mapped to the first address data; and converting the first address data with the detected address data.

Response to Arguments

6. Applicant's arguments filed 6/24/03, in regard to claims 1-10 have been fully considered but they are not persuasive.

Applicant argues that there is no disclosure in Backes of a packet transmitted over the first communication system containing both first data address conforming to the first network format and second address data conforming to a second network format. Further, applicant argues, "in Backes, to the extent any address translation is accomplished, it is done without the transmission of the new address format with the initial address format in the packet transmitted over the first communication system.

In response, it is stated that Bakes discloses, refer to col. 2 lines 30-40, means for writing **a representation of the multicast address into second frame** and for -----**second frame to have the station interpret the representation of the multicast address and recover the multicast address**. Further, refer to fig. 6, Backes discloses, "**encapsulation**" which reserves the address to indicate that multicast address must be recovered from information stored within the

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frame, refer to col. 5 lines 8-20. This address is included in the format of packet, refer to fig. 6A, in addition to DSAP (destination service access point) 230, which is logical address of the specific service entity, refer to col. 4 line 55.

Further, Backes discloses that there is no direct translation of the original multicast address into an address on the second LAN, instead there two addresses, DSAP, intended address, refer to fig. 6A, and encapsulation of another destination address, refer to fig. 6 A., and refer to col. 3 lines 30-40.

In addition, Killian (US Patent No. 5,940, 394) discloses two addresses in the packet- second address is encapsulated in the same packet transferred to different sub-network, refer to abstract, refer to fig. 3 and col. 3 lines 40-45 and col. 4 lines 58-67.

In the light of these explanations, arguments by applicant are not persuasive.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Conclusion

8. Any enquiry concerning this communication should be directed to Inder Mehra whose telephone number is (703) 305-1985. The examiner can be normally reached on Monday through Friday from 8:30AM to 5:00 PM.

If attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Seema Rao, can be reached on (703) 308-5463. Any enquiry of a general nature of relating to the status of this application or processing should be directed to the group receptionist whose telephone number is (703) 305-4700.

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC. 20231

Or faxed to (703) 872-9314.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal drive,
Arlington, VA, sixth floor (Receptionist).

Inder Mehra
Inder Mehra

8/31/03

August 31, 2003

DANG TON
PRIMARY EXAMINER